

**REMARKS**

Claims 1-31 are pending.

Claims 1-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Herz et al. (U.S.P. 5,754,938).

The rejection is traversed.

**OFFICE ACTION IS INCOMPLETE: FINALITY IS PREMATURE AND SHOULD BE WITHDRAWN**

The previous Office Action mailed May 28, 2004 (prior Action) objected to claim 14 under 37 CFR 1.75(c) as being in improper form contending the term "dream" is nonfunctional descriptive matter, and rejected claims 1-31 under 35 U.S.C. 102(b) as being anticipated by Herz et al. (U.S.P. 5,754,938).

In response to the prior Action, Applicants filed an Amendment on August 30, 2004 (previous Response). To overcome the objection to claim 14, Applicants argued that claim 14 is in proper dependent form, as written, since as set forth in MPEP 2106.IV.B.1(b) "nonfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. 101."

Applicants traversed the rejection of claims 1-31, arguing, for example, that Herz does not teach "representation of a client," but merely a collection of attributes. In addition, Applicants argued that Herz does not teach "display information in which client representation information of said one client and client representation information of other clients. . . are positioned at predetermined locations in response to a receipt of said client identification information," but rather that Herz merely teaches a target object as information other than information of relating the user who requested the creation of the hierarchical cluster tree. Further, Herz does not include a node representing the user who requested the creation of the hierarchical cluster tree.

In item 1 of the current Action, entitled Response to Arguments, the Examiner indicates that "arguments are addressed in the following final rejection and expressly at para. 3 and 9." However, in item 3, regarding the objection of claim 14, the Examiner merely contends that a "further limitation must be functional or structural, and "dream" is not." In item 9, the Examiner merely responds to arguments in the previous Response regarding the dependent claims.

The Examiner does not address, at all, the arguments presented in the previous Response regarding the objection to claim 14, and does not address, at all, arguments

presented in the previous Response traversing the rejection of independent claims 1, 15, and 22.

Applicant submits that the current finality of the Office Action should be withdrawn. As set forth in MPEP §707.07(f) entitled Answer All Material Traversed:

an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.

The current Action is incomplete since the Examiner has not responded, at all, to many of the arguments traversing the rejections. In addition, as set forth in MPEP § 706.07(d):

(i)f, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection.

### **Summary**

Applicant requests withdrawal of the finality of the current Action as incomplete and premature.

### **TRAVERSE OF REJECTIONS**

Since the Examiner has not responded to Applicants arguments submitted in the previous Response traversing the objection of claim 14 and rejection of claims 1-31, the same are substantially summarized herein.

#### **ITEM 14: OBJECTION TO CLAIM 14 UNDER 37 CFR 1.75(c)**

The Examiner objects to claim 14 under 37 CFR 1.75(c) contending claim 14:

... as being of improper dependent form for failing to further limit the subject matter of a previous claim. . . A "dream" is nonfunctional descriptive matter.

See MPEP 2106.IV.B.1(b), first paragraph.

(Action at page 2).

In item 3 the Examiner indicates that a "limitation must be functional or structural, and "dream" is not."

Dependent claim 14 recites a computer system according to claim 1 "wherein said genre is defined for a dream of a client . . . , and wherein, if a client specifies a genre other than those that are prepared in advance at a client registration, said genre specified by the client is added to available choice items for a next registration." Claim 1 recites a computer system including "means for transmitting, to said terminal of said one client, display information in which client representation information of said one client and client representation information of other clients, who belong to a genre registered by said one client in advance. . . ."

Applicants submit that claim 14 complies with 37 CFR 1.75(c) and is in proper dependent form. As set forth in MPEP 2106.IV.B.1(b):

(n)onfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. 101. The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter.

As understood in the art a "genre" is a "type or class," and the term --dream-- is understood in the art to include "a deep aspiration." (See, for example, The American Heritage® Dictionary of the English Language: Fourth Edition.2000). The term --dream-- as recited in claim 14 limits the term --genre-- in dependent claim 14 and the statutory process implemented by independent claim 1.

### **Conclusion**

Withdrawal of the objection to dependent claim 14 is requested.

### **ITEMS 5-6: REJECTION OF INDEPENDENT CLAIMS 1, 15, 22, AND 30 (AND RESPECTIVE DEPENDENT CLAIMS (2-14, 16-21, and 23-30) UNDER 35 U.S.C. §102(b) BY HERZ**

The Examiner rejects independent claims 1, 15, 22, and 30 (and respective dependent claims (2-14, 16-21, and 23-30) under 35 U.S.C. §102(b) as being anticipated by Herz. (Action at pages 2-3).

Herz does not support an anticipatory-type rejection by not teaching features recited in the present application's claims.

Independent claims 1, 15, 22, and 30, respectively, recite a computer system, a computer-readable storage storing a program for controlling a computer to provide information, a method, and an information acquisition method including, using claim 1 as an example, "means for receiving client identification information from a terminal of one client; and means for transmitting, to said terminal of said one client, display information in which client representation information of said one client and client representation information of other clients, who belong to a genre registered by said one client in advance, are positioned at predetermined locations in response to a receipt of said client identification information."

According to aspects of the present invention, display information including the client representation information for one client who requested to display the display information is transmitted to a terminal of a client. Such a display of a relationship between that one client and other clients is necessary to encourage communication.

A search profile taught by Herz does not teach "client representation information," as the Examiner contends. Rather, Herz teaches that a "search profile is a profile consisting of a collection of attributes, such that a user likes target objects whose profiles are similar to this

collection of attributes, is termed a "search profile" or in some a "query" or "query profile."

That is, Herz does not teach representation of a client but rather a collection of attributes.

Herz does not teach that "display information in which client representation information of said one client and client representation information of other clients. . .are positioned at predetermined locations in response to a receipt of said client identification information," as the Examiner contends.

Herz merely teaches (col. 24, lines 12-18) a hierarchical clustering that: produces a tree which divides the target objects . . . until the collection of target objects has been entirely divided into "clusters" consisting of a single object each. Herz further teaches (col. 4, lines 47-50) an object available for access by the user, which may be either physical or electronic in nature, is termed a "target object"

That is, Herz teaches a target object as information other than information of relating the user who requested the creation of the hierarchical cluster tree, and the hierarchical cluster tree does not include any node representing the user who requested the creation of the hierarchical cluster tree.

The Examiner also contends that the virtual community discussed by Herz teaches that one client and other clients who belong to a genre are "registered by one client in advance." However, Herz merely teaches (col. 24, lines 11-27) that "target objects" are displayed.

## **CONCLUSION**

Since features of independent claims 1, 15, 22, and 30 (and respective dependent claims (2-14, 16-21, and 23-30) are not taught by the cited art, the rejection should be withdrawn and claim 1 allowed.

## **REQUEST FOR IN-PERSON INTERVIEW**

Applicants also request conduct of an in-person interview to advance the prosecution of this case

### **Conclusion**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge

the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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